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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,093	10/04/2000	Shridhar P. Joshi	47079-00064	1828

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EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/06/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,093

Applicant(s)

JOSHI, SHRIDHAR P.

Examiner

Aaron J. Capron

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 29-39, 46-55 and 94-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 29-39, 46-55 and 94-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

This is a response to the Amendment received on September 29, 2003, in which claims 99-102 were added. Claims 26, 29-39, 46-55 and 94-102 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2003 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26, 29, 31-36, 39, 94-95, 97-99 and 101-102 are rejected under 35 U.S.C. 102(e) as anticipated by Acres (U.S. Patent No. 6,254,483; hereafter "Acres") or, in the alternative, under 35 U.S.C. 103(a) as obvious over Acres in view of IGWB.

Acres discloses a gaming machine comprising a processor for randomly selecting a plurality of outcomes in response to a wager amount, the processor monitoring time signals from

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a clock; a display for displaying the appearance for a wagering game; a memory device coupled to the processor and storing at least two data sets for producing two different appearances for the gaming machine (3:15-20), the processor automatically selecting one of the at least two data sets primarily in response to the processor monitoring a time signal corresponding to a predetermined time (abstract). It is inherent that all gambling games have a theme/artwork. Most casinos use equivalent gaming machines, but have different artwork to distinguish themselves from their competitors. In the alternative, where the interpretation of appearance does not include thematic game artwork, IGWB discloses the use of reconfiguring the theme of the game machine so that the winning symbols are changed from three sevens to cherries or cabooses (IGWB pages 11, 2-4 full paragraphs) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the references in order to change the manner in which the player perceives the electronic gaming machine (Acres 3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the themed artwork of IGWB into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine.

Referring to claim 29, Acres discloses using a video display (abstract), such as a video poker machine.

Referring to claim 31, Acres discloses changing the audio and appearance of the machine in response to time (3:15-20).

Referring to claims 32 and 33, Acres discloses a gaming machine that includes the visual elements are associated with the plurality of outcomes (status of the player) and the timing of the game (3:15-20).

Referring to claims 34-36, Acres discloses a gaming machine that includes scheduling/programming for timed events such as one day before a holiday to one day after the holiday (Figure 5).

Referring to claim 39, Acres discloses the clock is internal to the processor.

Claims 94-95 and 97 correspond in scope to a method set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim 98 corresponds in scope to a gaming machine set forth for use of the method listed in the claims above and is encompassed by use as set forth in the rejection above.

Claims 99 and 101-102 correspond in scope to a gaming system and method set forth for use of the gaming method listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 46-53, 96 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres.

Referring to claim 46, Acres discloses a method of operating a gaming machine that includes displaying, on a video display (1:17-19) a plurality of standard game appearances (1:58-2:11); monitoring real time (6:51-54); automatically (abstract-predetermined changes) displaying

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modified game appearance, the appearance of the game altering with respect to a holiday (2:46-52); randomly selected a plurality of outcomes of the gaming machine in response to the wager amount (slot machine). However, Acres does not specifically disclose the themed artwork being associated with a holiday. Acres discloses that background color and card decorations can be reconfigured when in configuration mode. Acres further discloses that the appearance of the game can be altered based upon a societal event such as a holiday. It would be obvious to one of ordinary skill in the art to alter the gaming machine's background colors based upon the time of year of a societal event (for example brown/orange for Halloween and/or red/pink for Valentine's Day) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the provide themed artwork correlating to the holiday since Acres discloses altering appearance of the game based upon a predetermined time, the predetermined time being a holiday in order to change the manner in which a player perceives the gaming machine (3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate themed game artwork having a holiday motif into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine.

Claim 30 corresponds in scope to gaming machine set forth for use of method listed in the claims above and is encompassed by use as set forth in the rejection above.

Referring to claims 47, Acres discloses using an external clock in a hub server (Figures 1, 3 and 5, ref 24).

Referring to claim 48, Acres suggests using a clock that is internal to the processor (5:47-50 and abstract with reference to predetermined changes in variable such as time).

Referring to claims 49 and 51, Acres discloses the steps of displaying include the steps of downloading data corresponding to the game artwork (1:33-57).

Referring to claim 50, Acres discloses using steps to download data from a server (Figures 1, 3 and 5, ref 24).

Referring to claims 53, Acres teaches a game machine programmed to alter game display for timed or calendar events such as holidays (Figure 5).

Claim 96 corresponds in scope to a method set forth for use of the gaming machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Claim 100 corresponds in scope to a method set forth for use of the gaming machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Claims 30, 46-53, 96 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres in view of IGWB.

Referring to claim 46, Acres in view of IGWB disclose a method of operating a gaming machine that includes displaying, on a video display (1:17-19) a plurality of standard game appearances (1:58-2:11); monitoring real time (6:51-54); automatically (abstract-predetermined changes) displaying modified game appearance, the appearance of the game altering with respect to a holiday (2:46-52); randomly selected a plurality of outcomes of the gaming machine in response to the wager amount (slot machine). However, Acres does not specifically disclose the themed artwork being associated with a holiday. Acres discloses that background color and card decorations can be reconfigured when in configuration mode. Acres further discloses that the appearance of the game can be altered based upon a societal event such as a holiday. It would be

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obvious to one of ordinary skill in the art to alter the gaming machine's background colors based upon the time of year of a societal event (for example brown/orange for Halloween and/or red/pink for Valentine's Day) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the provide themed artwork correlating to the holiday since Acres discloses altering appearance of the game based upon a predetermined time, the predetermined time being a holiday in order to change the manner in which a player perceives the gaming machine (3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate themed game artwork having a holiday motif into the gaming machine of Acres and IGWB in order to change the manner in which a player perceives the gaming machine.

Referring to claims 47, Acres discloses using an external clock in a hub server (Figures 1, 3 and 5, ref 24).

Referring to claim 48, Acres suggests using a clock that is internal to the processor (5:47-50 and abstract with reference to predetermined changes in variable such as time).

Referring to claims 49 and 51, Acres discloses the steps of displaying include the steps of downloading data corresponding to the game artwork (1:33-57).

Referring to claim 50, Acres discloses using steps to download data from a server (Figures 1, 3 and 5, ref 24).

Referring to claims 53, Acres teaches a game machine programmed to alter game display for timed or calendar events such as holidays (Figure 5).

Claim 30 corresponds in scope to gaming machine set forth for use of method listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim 96 corresponds in scope to a method set forth for use of the gaming machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Claim 100 corresponds in scope to a method set forth for use of the gaming machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Claims 37-38 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres in view of IGWB New '97 Games (hereafter "IGWB").

Acres discloses using game artwork but does not disclose using animated characters. However, IGWB discloses using character animation to provide enjoyment to the game (Pages 15-16: The paragraph on page 15 starting with "To present slots..." to the fourth full paragraph on page 16) in order for casinos to distinguish themselves from other casinos and to add extra excitement to the game. The two references are analogous since both references refer to gaming machines using themes/artwork. One would be motivated to combine the references in order to provide extra enjoyment to Acres game by adding animated characters and thus, attract more players. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the animated characters of IGWB into the invention of Acres in order to enhance player enjoyment.

Referring to claims 54 and 55, Acres in view of IGWB disclose a plurality of modified visual elements (IGWB: page 1, paragraphs 1-4) that are player selectable (video poker machines 1:58-2:11) and that are non-selectable (slot machines).

Response to Amendment

The declaration under 37 CFR 1.132 filed September 29, 2003 is insufficient to overcome the rejection of claims 26, 29-39, 46-55 and 94-102 based upon the lack of novelty and obviousness as set forth in the last Office action because:

(1) There is no nexus between the merits of the claimed invention and the opinionated statements of Mr. Nicastro. The term nexus designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness, see *Demarco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. Denied, 488 U.S. 956 (1988);

(2) There is no factual evidence supporting that alternating thematic game artwork will lengthen the commercial life of the gaming machine, see *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) and the expert testimony is deemed as opinionated without any factual evidence; and

(3) Even though Mr. Nicastro may be an expert in design, development and production of wagering entertainment devices, he is shown to be an expert in law in order to determine the non-obviousness of an invention.

Response to Arguments

Applicant's arguments filed September 29, 2003 have been fully considered but they are not persuasive.

Applicant argues that Acres cannot create a theme as none of the generic items mentioned by Acres taken together invokes a specific subject. Applicant asserts that a theme is a variety of elements that, when together as a whole, invokes a mental association with a specific subject (Paper #16, top of page 11). However, Acres disclose changing the appearance of the gaming machine with respect to a predetermined time (abstract, 3:15-20) in order to change the manner in which the player perceives the gaming machine (3:15-16). The term “perceive” is defined as to achieve understanding of, apprehend (The American Heritage Dictionary of the English Language, Third Edition copyright 1992). Merely altering the background color and/or the card decoration will not change the manner in which a player perceives the gaming machine as asserted by Applicants in Paper #16, page 11 which states in part “Such background appearance items...do not constitute thematic game artwork”, “For example, background color does not constitute a theme”, “card decoration is, again, merely generic appearance; it does not invoke a theme...even taken together background color and card decoration do not constitute a theme as these elements...to a theme”. In order to alter the appearance of the game machine in a manner in which the player perceives the game, without altering the game itself, the altering must involve the theme of the gaming machine. Changing the perception of the gaming machine would invoke a mental associated with a specific subject matter related to a theme. Therefore, the claimed invention fails to preclude the invention of Acres.

Applicant argues that Acres does not disclose a plurality of modified visual elements that are player selectable. However, Acres discloses a poker game (1:58-2:11) where the game appearance can be modifiable. After the modification of the poker gaming machine, the player can select which cards or visual elements to keep and/or discard. The claimed invention is not so

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limiting in a manner to exclude the poker game of Acres. Therefore, the claimed invention fails to preclude the invention of Acres.

Applicant argues that Acres does not teach modifying the game appearance in association with a holiday. Applicant further argues that Acres discloses changing the wager per unit time can be altered based upon the holiday season. However, Acres further discloses changing other parameters with respect to the holiday season (8:62-65) and changing the sound and appearance of the game equally applies. Acres discloses that gaming machines configuration parameters, such as game appearance (abstract, 1:61-65), can be changed automatically in response to commands over the network. The commands are issued in response to predetermined changes in variables, such as time of day, week, month or year (abstract, Figure 5). Consequently, Acres allows for the ability to change the sound effects and appearance of the machine in response to time (3:17-18). Applicant's admission that Acres mentions altering game appearance based on time (Instant Remarks, pg 4) and that thematic game artwork varies from machine to machine (Remarks received 9/23/02, pg 9) are each noted. Hence, all machines inherently possess thematic game artwork. Further, the claim language is interpreted as being at least background imagery of that particular machine's theme. The instant disclosure fails to provide any definition and there is no generally accepted definition within the art of record. Thus, Acres's automatic altering of background is altering thematic game artwork. The language is not so limiting as requiring change of game symbology/elements. Therefore, Applicant's claimed invention fails to preclude Acres's invention.

The Applicant's admission with respect to replacing old software with new software that has new thematic elements programmed into the game has been noted (Page 14, last full paragraph).

Therefore, in consideration of the filed declaration and the remarks, taken as a whole, fail to outweigh the anticipation/obvious holding.

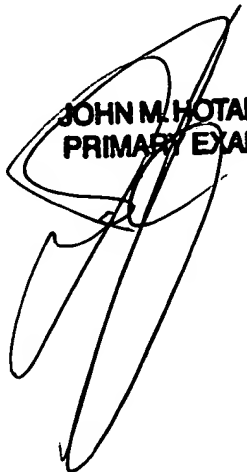
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc


JOHN M. HOTALING, II
PRIMARY EXAMINER